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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,034	09/16/1999	HIROYUKI ATAKE	DAIN:435A	8263

7590 11/14/2003

PARKHURST & WENDELL LLP
1421 PRINCE STREET SUITE 210
ALEXANDRIA, VA 223142805

EXAMINER

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/397,034

Applicant(s)

ATAKE, HIROYUKI

Examiner

Monique R Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13,14,17,18 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13,14,17,18 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

1. The request for reconsideration filed 9/4/03 has been entered. Claims 13-14, 17-18, and 21-25 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. Claims 13-14, 17-18 and 21-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for the reasons recited in the prior office action and restated below.

Claims 13, 17 and 21 recite the limitation "a coefficient of kinetic friction with respect to a flat glass plate in the range of 0.2 to 0.9" however considering the nature of the invention and the breadth of the claims, it is noted that the instant disclosure at the time of filing does not provide any method by which this kinetic friction range is obtain or a standard method utilized in the art for obtaining a coefficient of kinetic friction value with respect to a flat glass plate.

Considering the coefficient of kinetic friction is dependent upon the testing method by which the value is obtained, particularly the two materials between which the value is to be measured, the instant disclosure does not enable one skilled in the art to make the claimed invention because there is no description of the type of flat glass plate utilized in the process or the other process conditions. In terms of the state of the art, typically when citing a coefficient of kinetic friction one skilled in the art usually refers to the value obtained between two substrates of the same inventive material or one inventive substrate versus a standard substrate or material utilizing a

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standard method or a described method. In the instant case, the Applicant only recites that the coefficient of kinetic friction is measured against a flat glass plate but does not provide any information with respect to the flat glass plate such as type of glass and average flatness or roughness of the glass surface and further does not provide any working examples that one skilled in the art could look to for further direction. Therefore, considering there are numerous types of glass plates and an even greater variety of surface roughness ranges of these flat glass plates, the level of unpredictability would require undue or unreasonable experimentation by one having ordinary skill in the art to produce a decorative sheet as instantly claimed having a coefficient of kinetic friction in the range of 0.2 to 0.9 with respect to some unknown type of flat glass plate.

Response to Arguments

4. Applicant's arguments filed 9/4/03 have been considered but are not persuasive. The Applicant argues that the specification at Pages 4 and 5 as well as the results reported in Table 2 allegedly teach one skilled in the art how to practice the instantly claimed invention. However, the Examiner notes that though these sections provide a general description of the method utilized to test the friction coefficient, these sections provide no information with respect to the flat glass plate utilized in the tests and upon which the instant claims rely. As restated above, the coefficient of kinetic friction is dependent upon the testing method by which the value is obtained, particularly the two materials between which the value is to be measured. The instant disclosure does not enable one skilled in the art to make the claimed invention because there is no description of the type of flat glass plate utilized in the process or the other process conditions, specifically the flatness or roughness of the flat glass plate. Considering that the term

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“flat” is a relative term that is not defined by the claims or the instant disclosure, and considering there are numerous types of glass plates and an even greater variety of surface roughness ranges of these flat glass plates, the level of unpredictability would require undue or unreasonable experimentation by one having ordinary skill in the art to produce a decorative sheet as instantly claimed having a coefficient of kinetic friction in the range of 0.2 to 0.9 with respect to some unknown type of flat glass plate.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read 'm. jackson', written in a cursive style.

Monique R. Jackson
Primary Examiner
Technology Center 1700
November 12, 2003